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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/634,704  | 08/05/2003  | Michael S. John      | 29888/38379A         | 7578             |
| 4743  | 7590        | 06/01/2005           | EXAMINER             |                  |
| MARSHALL, GERSTEIN & BORUN LLP<br>233 S. WACKER DRIVE, SUITE 6300<br>SEARS TOWER<br>CHICAGO, IL 60606 |             |                      | PELHAM, JOSEPH MOORE |                  |
|   |             | ART UNIT             | PAPER NUMBER         | 3742             |

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/634,704             | JOHN ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Joseph M. Pelham       | 3742                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 44-68 is/are allowed.
- 6) Claim(s) 1-3,5-7,9-34 and 43 is/are rejected.
- 7) Claim(s) 4,8 and 35-42 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 August 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/13/04, 5/19/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5, 6, 9-17, 29-34, and 43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 12-17, 21-23, 28, 43-48, and 53 of U.S. Patent No. 6,602,202. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant independent claims merely broaden the scope of the patented claims, relegating certain features to dependent claims.

Claims 16, 17, and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 8, and 14 of copending Application No. 10/834,554. Although the conflicting claims are not identical, they are not patentably distinct from each other because again the instant claims substantively only broaden the scope of the cited copending '554 claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner recognizes that claims now rejected below over prior art, in addition to the double patenting rejections above, were allowed in the related US'202 patent. Further search and consideration has recognized new grounds of rejection.

***Claim Rejections - 35 USC § 102***

Claims 16, 17, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 5916174 (US'174).

Referring to col. 1, lines 40-54 (1:40-54), 2:31-55, 5:46-6:18, and 10:3-4, US'174 discloses a digital signal transduced to create an steady-state auditory test signal ("long duration pure tones" (5:61), sensing a potential (AEP – auditory evoked potential) while presenting the signal, an "on" and "off" duration, and analysis of the potential to detect a response.

***Claim Rejections - 35 USC § 103***

Claims 18, 19, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'174 in view of U.S. Pat. 6503207 (US'207).

The claims differ from US'174 only in calling for an acoustic stimulus comprising "clicks," automatic or manual control of "on" and "off" durations, and the "off" duration corresponding to a subject recovery period.

US'207 discloses, at 3:57-67, an acoustic stimulus comprising "clicks;" and neither of automatic nor manual signal duration control, nor an "off" duration corresponding to the recovery period can be regarded to patentably distinguish the claimed invention from the prior art. Manual duration control has long been conventional and remains in common use, for instance by the expert practitioner and/or where diverse testing regimes are administered, and automatic control is used where standardized testing regimes are the norm; moreover, it is well known to afford the testing subject a suitable recovery period to minimize the residual effect of a prior test signal; hence such would have been obvious to ordinary skill in the art. It would have been obvious to utilize "clicks" where primarily more basic measures of auditory function are desired.

Claims 25, 26, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'174 in view of U.S. Pat. 4622440 (US'440).

The claims differ from US'174 only in reciting the programming of a hearing aid for a specified number of frequency bands, by means of the recited acoustic testing steps (audiometric results), where the gain for each frequency band is a function of the detection of a subject response.

US'440 discloses , at 4:4-26, the programming of a hearing aid for a specified number of frequency bands, by means of audiometric results, where the gain for each frequency band is a function of the detection of a subject response. It would have been obvious to program a hearing aid with the test results of US'174 since such is in fact the ultimate object of such a test, where a hearing aid is medically indicated, and US'440 discloses such integration of programming and testing functions to have been well known.

Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'174 in view of U.S. Pat. 5023783 (US'783).

US'174 discloses substantially all of the recited subject matter, as discussed above, except noise masking of the test signal by band-pass spectra noise.

US'783, at 8:23-26, discloses noise masking of the test signal by band-pass spectra noise. It would have been obvious to thus mask the test signal to avoid spurious responses, as taught by US'783.

Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'174 in view of U.S. Pat. 4038496.

The claims differ from US'174 only in reciting exponential modulation of test signal frequency.

US'496 discloses, at 10:57-64, exponential modulation of audiometric test signal frequency. It would have been obvious adapt the modulation function of US'496 to the test signal of US'174 to sweep through a specific and substantial portion of the audible range.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US'174 in view of US'207.

The claims differ from US'174 only in calling for an acoustic stimulus comprising transient components. US'207 discloses, at 3:57-67, an acoustic stimulus comprising transient components, or "clicks." It would have been obvious to utilize "clicks" where relatively more basic measures of auditory function are desired.

**Allowable Subject Matter**

Subject to the filing of a terminal disclaimer, claims 4, 8, 20, 29-42 are objected to as being dependent upon a rejected base claim, but appear to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Subject to the filing of a terminal disclaimer, claims 9-15 and 44-68 appear to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph M. Pelham whose telephone number is 571-272-4786. The examiner can normally be reached on M-F 7:30 AM to 4:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMP 5/20/05

JOSEPH PELHAM  
PRIMARY EXAMINER